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EXAMINER

CUFF, MICHAEL A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,339

Applicant(s)

TAKAYAMA, HISASHI

Examiner

Michael Cuff

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 9-12, 22, 24-29, 31, 35, 36, 39-41, 43, 44, 49-56, 61-63, 75-78, 93, 95-106 and 142-144 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 9-12,22,24-29,31,35,36,39-41,43,44,49-56,61-63,75-78,93,95-106 and 142-144.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment, filed 6/9/03, has been received and entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electronic wallet, the electronic payment card settlement means, the payment card issuing means, the service means, the service providing means, the first, second, third, fourth storage means, display means, optical communication means, selection means, automatic providing means, communication means, subscriber information storage means, and member shop information storage means must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The applicant made an effort to fix this problem. However, merely defining terms in the prosecution is not going to help one understand the patent when it issues. The explanations provided should be incorporated into the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12, 22, 27, 28, 35, 36, 39, 49-56, 61, 63, 93, 24-26, 29, 31, 40, 41, 43, 44, 97, 98, 62, 75, 76, 77, 78, 95, 96, 99-106, and 142-144 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following terms have been claimed but not properly defined and itemized in the specification or the drawings. It is unclear as to what the scope and definition of these terms: the electronic wallet, the electronic payment card settlement means, the payment card issuing means, the service means, the service providing means, the first, second, third, fourth storage means, display means, optical communication means, selection means, automatic providing means, communication means, subscriber information storage means, and member shop information storage means.

Note that the mere repeating of the vague claim language in the summary of the invention does not make these terms clear.

The applicant made an effort to fix this problem. However, merely defining terms in the prosecution is not going to help one understand the patent when it issues. The explanations provided should be incorporated into the specification. Additionally, the examiner requests that applicant double check the item numbers in explanations. (i.e. in (1) , the mobile user terminal is 100, not 10). In general, the examiner is having trouble understanding the need to make up new terms. It just makes it more confusing.

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For example, in (2) "electronic payment card settlement means" corresponds to merchant terminal 102. Why not claim the merchant terminal?

The examiner also finds the terms like "first storage means" which correspond to the ROM of the mobile user terminal (which also the "electronic wallet"), the merchant terminal, the accounting machine and the gate terminal to be unclear. Which one is it? Consistency in claim language is important. Since applicant has 195 claims and hundreds of pages of specification, consistency and clarity are essential.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-12, 22, 27, 28, 35, 36, 39, 49-56, 61, 63 and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Teicher.

Teicher shows, figure 3, a system and method for retail (mobile electronic commerce system). Figure 3 a detailed block diagram illustration of the payment system 7. Electronic wallet 9 (electronic wallet and payment card) which is personal to a customer 12 who is making a purchase at POS 10, comprises an electronic purse 310 containing information identifying the amount of electronic cash stored in its register

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311. The electronic wallet also comprises an electronic checkbook 320 (ie electronic credit card), in which register 321 contains information identifying and authorizing transactions with at least one credit or bank account, made through processing centers of financial institutions 20. External interface 340 (second wireless communications unit) serves as an interface between the electronic wallet and payment units 8. External interface 340 comprises communication hardware as well as secured protocols for reading or altering the information stored in the electronic wallet (including wallet to wallet transfer capability). These protocols preferably include a requirement for keying-in a secret PIN (personal identification number) code via customer interface 352, as a precondition for any transaction with wallet 9. Interfaces 351, 352, 353, and 362 (first wireless communications unit)

Payment unit 8 comprises an automatic transaction manager 361, which controls all transactions executed with respect to electronic wallet 9. Automatic transaction manager unit 361 (service providing server) selects and controls the operation of three transaction units: an electronic purse payment unit 363, electronic purse loading unit 365 and an electronic checkbook transaction unit 366. For each payment request received from POS 10 through POS interface 353, automatic transaction manager unit 361 selects the transaction or transactions to be executed and accordingly selects which of the units 363, 365 and 366 to activate.

Electronic purse payment unit 363 (electronic payment card settlement means) communicates with electronic purse 310 of electronic wallet 9. When unit 363 is activated to pay a purchase sum required by POS 10, it operates to reduce the amount

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of electronic cash stored in register 311 by the purchase sum, while increasing the amount of electronic cash stored in an electronic cash drawer 364 by the same sum.

Card interface 351 includes hardware and protocols known in the art for secured communication with electronic wallet 9. It may include mechanical means operative to retain an electronic wallet during transaction and to release it upon the transaction completion. It may use contactless communication (wireless) or even allow remote transactions by using a suitable communication means. For example, a wireless communication link may serve to collect payment in a toll road without stopping the car, or for collecting payment for a card used with a cellular telephone.

As an optional feature, payment unit 8 may include a customer interface 352, for example a keypad and a display, operative to display status information and to allow adding a Personal Identification Number (PIN) (uniquely described). As is well known in the art, a PIN is a secret code, which serves as an electronic signature to enhance transaction security. If more than one central account is accessible by electronic checkbook 320, the customer may use customer interface 352 to select the account to be charged.

Merchant interface 362 may be any communication link which enables the owner and/or operator of the retail system of which payment unit 8 is part of to enter operation parameters into automatic transaction manager 361 (settlement process), for example the minimal electronic checkbook payment sum. A non limiting example is that of a communication link to the merchant's office computer.

Remote account interface 370 incorporates hardware and protocols known in the art for secured communication with transaction processing centers of financial institutions 20, respective to the accounts identified by register 321 of electronic checkbooks 320 included in the customers' electronic wallets 9. The communication (service means) can be either on line or off-line. Non limiting examples of on-line communication means include dial-up telephone lines, dedicated lines or cellular data communication (wireless, many options). A non limiting example of off-line communication means is a hand held terminal for unloading transaction information from payment unit 8 when visiting them, and downloading the information thereafter to processing centers of financial institutions 20 by communicating with them from the merchant's office. These hand held terminals may work the other way, i.e. unloading information from the financial institutions thereinto at the merchant's office and downloading this information into payment units 8 during a visit.

Electronic safe 368 is an electronic storage device for temporary electronic storage of central transactions executed in an off-line communication. Transaction orders are stored in the electronic safe 368 until they are downloaded for batch processing during a communication session with the transaction processing centers of financial institutions 20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-26, 29, 31, 40, 41, 43, 44, 97, 98, 62, 75-78, 95, 96, 99, 100-106, 142-144, 174-177 and 141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teicher, as applied above, in view of Matsunaga et al.

Teicher shows all of the limitations of the claims except for specifying ferroelectric nonvolatile memory, specific communications and specific security and verification methods.

Matsunaga et al. teaches, figure 1, a ferroelectric nonvolatile memory in order to improve the battery.

Based on the teaching of Matsunaga et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the battery in order to improve the battery.

There are many types of security, verification, and communication methods available in order to provide secure, safe and efficient communication.

Based on the discussion above, the examiner takes Official Notice that the security and communication variations would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Teicher security system in order to provide secure, safe and efficient communication.

Response to Arguments

Applicant's arguments filed 6/9/03 have been fully considered but they are not persuasive.

Applicant asserts that the information stored in the electronic wallet of Teicher is totally different from the present invention. The examiner does not concur. The claims do not recite a difference. The Teicher reference meets the metes and bounds of the claims as broadly recited.

Applicant asserts that security information cannot be renewed. This is not claimed. The Teicher reference meets the metes and bounds of the claims as broadly recited.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Michael Cuff 8/11/03
Michael Cuff
August 11, 2003